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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,797	08/18/2003	Liang-Yu Lin	JOYP0001USA	1796

27765 7590 04/19/2006

NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION
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EXAMINER

SPRIGG, SEAN M

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/604,797

Applicant(s)

LIN ET AL.

Examiner

Sean Sprigg

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8-16-03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Claim Objections

1. Claims 2, 9-10, 15-16, 18-19 is objected to because of the following informalities: spaces are missing between otherwise separate words, such as the words "vertically" and "lined-up" being represented as "verticallylined-up" and the words "sequentially" and "setting" being represented as "sequentialysetting." Additionally, "sequentially" should be spelled --sequentially—. These appear to be typographical errors. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: receiving a player input and moving the cursor based on the player input. This step is essential to the game play because without it, the cursor does not move and the objects are not affected in a way that would carry out the normal game play as described in the specification. Additionally, without player input causing a cursor to move, the entire process could occur without a player, the only way that the deleting step would occur is if the grid were already initialized with objects wherein some of the objects are lined-up, in which case a second step initializing the positions of various objects would also be omitted. It is also unclear as to how the method as described in the specification would be performed

Art Unit: 3712

without a step of repeating certain steps, such as moving the cursor in response to a received user input, deleting any lined-up objects of the same type, moving objects down in response to the deletion, creating a new row of objects and shifting the row into the grid. The repeating step appears to be essential as it provides for continual interaction until an end game result occurs and is outputted in a tangible manner, such as a display. The method as currently claimed, therefore, omits essential steps of allowing player interaction with the game method and actually executing the game method as described in the specification and detailed on Fig. 9.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. "The claimed invention as a whole must produce a useful, concrete, and tangible result" in order to fulfill the utility requirement. Specifically, the method of claims 1-20 does not provide any tangible result. The method steps of claim 1 indicate that the playing grid, cursor, and objects perform certain actions under certain conditions, with the actions occur exactly once and the last step of the game being "shifting all other objects...up." As best understood, the method's intended result is to provide entertainment, an intelligence test, or a test of hand-eye coordination on the display a small portable electronic device for at least one player. As currently claimed, there is no display on which the method is performed, no display of grid or other elements of the method, and there is no display of a final result to the user. The

Art Unit: 3712

currently claimed final step of "shifting...objects up" does not provide any useful or tangible result as it is merely manipulating an abstraction of the grid and the objects in the grid. The steps of "providing a playing grid" and "providing a cursor" could be abstractly or mentally performed and the grid and cursor themselves do not constitute a "tangible result" because they are not necessarily tangible (they could be mental images) nor are they results of the method. Finally, the method of claim 1 lacks in providing any tangible result by not providing entertainment in the form of wins and losses or the like, the score of an intelligence test, or a score of a test of hand-eye coordination. It is noted that while claim 4 limits the method to provide for an end game situation and claims 9-11 and 18-20 limit the method to provide target values that essentially increase skill levels, these limitations do not provide a tangible result in the form of an award, a message to the player being displayed, an audio indication, or other tangible result of the game method. It is noted that while claim 21 does provide some form of tangible result in displaying a message that is inputted by a player through an input means, the result it is displaying does not correspond with the game method steps provided in claims 1-20 and, therefore, does not provide a tangible result for playing the game. Because claims 1-21 are lacking in providing a useful, concrete, and tangible result, they lack utility and are rejected under 35 U.S.C. 101.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yamagami'032 (USPN 6,458,032) and Nakata'350 (US Pub. No. 2003/0040350) teach puzzle games with block elements that are eliminated when

Art Unit: 3712

manipulated by the player to be in certain combinations with each other, the rising of blocks in rows, moving blocks when no adjacent block is below the it, and other features of the game except for a cursor occupying a cell that when moved toward an object in an adjacent object, exchanges positions with the adjacent object. "Tetris Attack" article from Wikipedia last modified on April 3, 2006 also describes a game "Tetris Attack" which was released on October 27, 1995 with similar features, but also does not teach a cursor as described above. "Super Collapse" article on rottentomatoes.com describes a game "Super Collapse!" released on January 1, 2002 having a new row of objects with a timer that periodically appends a randomly selected type to an end of the new row until it is filled and then shifts the row into the grid, but also does not teach a cursor as described above.

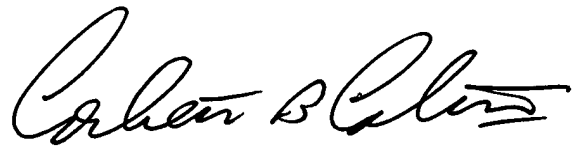
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Sprigg whose telephone number is (571) 272-5562. The examiner can normally be reached on Monday - Friday, 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3712

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SMS
4/11/06

A handwritten signature in black ink, appearing to read "Corbett B. Coburn", with a stylized flourish at the end.

CORBETT B. COBURN
PRIMARY EXAMINER